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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,488	01/18/2002	Scott G. Williams	4818-002	1424

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EXAMINER

SHAKERI, HADI

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 07/29/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/051,488

Applicant(s)

WILLIAMS, SCOTT G.

Examiner

Hadi Shakeri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-16 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-16 and 18-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 06.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION*****Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

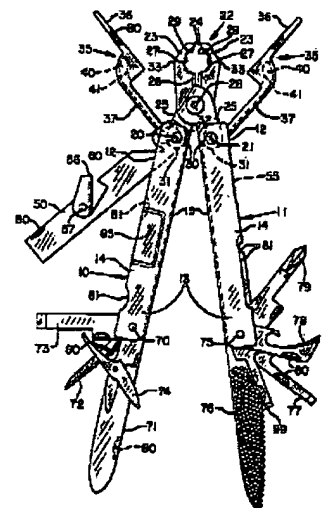
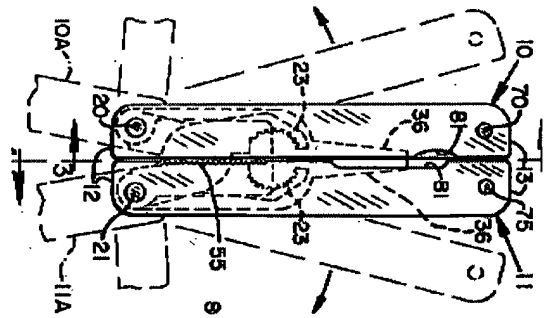
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4-7, 10, 15-16 and 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Leatherman, US Patent No. 4,238,862.

Leatherman discloses all the limitations of claim 1 and 15, i.e., a foldable tool, having a plurality of tools comprising a foldable handle movable between a folded position and an open position, a series of tools mounted to the foldable handle structure with each tool being movable from a storage position within the handle to an operative position projected outside the handle. Handles having channel, a wick cutter, i.e., pliers (22) with jaws (23) pivotally connected about a pivot pin (28) with legs connected to the handles. Regarding the narrative and /or functional language, e.g., "candle" tool, lacking any structural limitations to define the tool, prior art, e.g., Leatherman is considered to meet the language.

Regarding claims 2-7, 10, 16, 17, 20 and 20-22 Leatherman meets the limitations, e.g., "wick" cutter (22 with cutters 26) or (74), a "wick" dipper, e.g. (73), a "match" holder (35) and candle digger either one of (76) - (80).

Regarding claim 23, an "L-shaped" wick dipper (79).



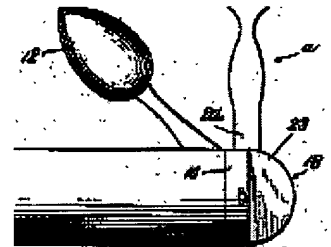
**Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leatherman in view of Gross.

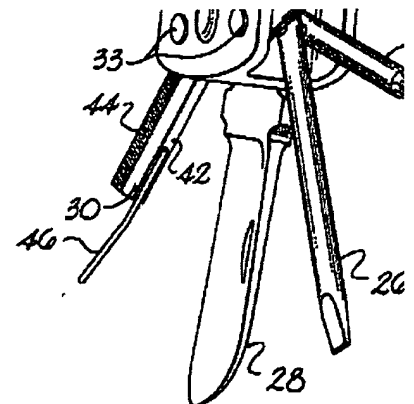
Leatherman discloses all the limitations of claim 8, including foldable tools, e.g., (71) (76) which are capable of meeting the function of a "scoop", however, Leatherman does not disclose a tool meeting the accepted terminology of a "scoop", i.e., a rounded or hollow structure. Gross teaches a combination tool having foldable spoon (12). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the tool of Leatherman with a foldable tool in form of a spoon as taught by Gross to adapt the combination tool to accommodate various utensils for use at the table.



Regarding claim 19, Leatherman as modified by Gross meets the limitations, i.e., a wick dipper, e.g., (77), an "alligator" clip, (35).

5. Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leatherman in view of Brown, Jr.

Leatherman discloses all the limitations of claim 9, except for an arm secured to one of the handle and a generally L-shaped wire secured to a terminal end of the arm and extending therefrom. Brown,



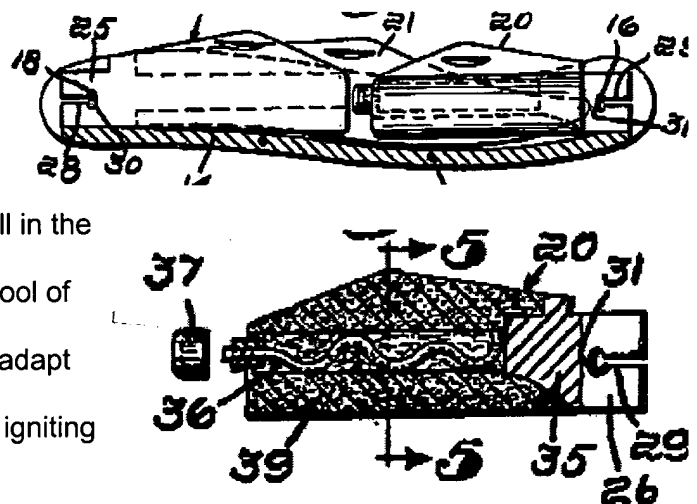
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Jr., teaches a combination tool with an arm, foldable file (44) having wire tool (30). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the tool of Leatherman with the file and wire tool as taught by Brown Jr., to adapt the combination tool for cleaning spark plugs and for cleaning hard to reach crevices.

Regarding claim 15, Leatherman as modified by Brown, Jr., meets the limitations.

6. Claims 11, 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leatherman in view of Alexander.

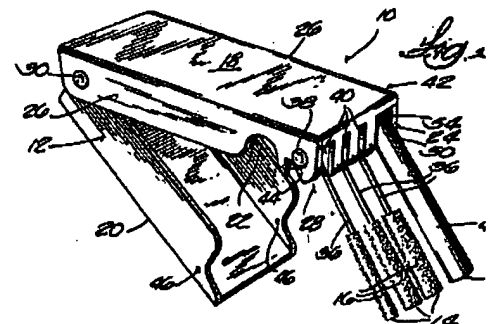
Leatherman discloses all the limitations of claim 11, except for a pre-fueled lighter. Alexander teaches a combination tool with a foldable lighter (20). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the tool of Leatherman with the lighter as taught by Alexander to adapt the combination tool for sportsmen carrying means for igniting a fire.



Regarding claims 12 and 24, Leatherman as modified by Alexander meets the limitations, i.e., the tool including a sleeve (39 including the cavity 36), having an expandable and retractable wick, i.e., the wick (36) can be pulled out or pushed in the sleeve.

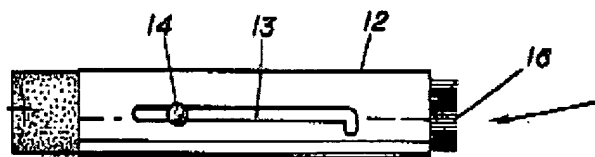
7. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leatherman in view of Halverson and Wells.

Leatherman meets all the limitations of claim 13, except for a tool including a sleeve adapted to receive a swab extended and



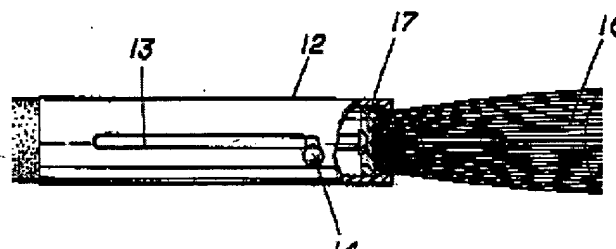
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retracted by an actuator. Halverson teaches a foldable combination-cleaning tool. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the tool of Leatherman with the foldable cleaning tool as taught by Halverson to adapt the combination tool for cleaning tasks.



Wells teaches a retractable brush for cleaning lenses or the like.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to further modify the modified tool of Leatherman and Halverson with the retractable brush as taught by Wells to adapt the combination tool for cleaning tasks such as hunting scopes wherein the brush is retractable when not in use to keep it clean.



Regarding claim 14, Leatherman as modified by Halverson and Wells meets the limitations, i.e., the brush being disposable.

### **Conclusion**

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Response to Arguments***

9. Applicant's arguments filed 06/02/03 have been fully considered but they are not persuasive. The arguments that the terms, e.g., wick cutter, constitutes structure and thus they are not anticipated by US '862, is not persuasive, since the tools as disclosed by US '862 is capable of performing the function. The claim limitations are not ignored but as indicated in the Office Action they are considered to be met by prior art, e.g., a "wick cutter" lacking any structural limitations to read over prior art, is considered to be met by either head (22) or the scissors (74), i.e., tools capable of performing the function. Examiner is in agreement with the applicant's argument that numerous court decisions stress the importance of the claim limitations, and all "explicit" claim language is considered but it is noted that, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In response to the argument that the Office Action is not clear, Examiner has pointed out all the limitations as they are met by the reference and agrees with the Applicant that inherency is not a matter of hindsight.

In response to applicant's argument that there is no suggestion to combine the references, (claims 8 and 19), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, a multiple tool of Leatherman is modified by Gross, to adapt the tool for various utensils, e.g., spoon, and the modified tool meet all the limitations and the argument, again, that the primary reference does not meet all the limitations, same as the argument that "eating" spoon is different from a "candle" spoon, is not persuasive as noted above, and the suggestion to modify the tool of Leatherman is clearly provided by the teaching, reference Gross, and the argument that greasy tool of Leatherman is not proper for eating is not persuasive either, since it amounts to arguing that the knife (71) as disclosed cannot be used to peel an apple. The argument that slight bend in Brown's tool does not meet the "L-shape" limitations is not persuasive, as it meets the limitations as recited. Regarding claims 11 and 12, member (20) of Alexander does define pre-fueled lighter including a sleeve (body/cavity 38/36) wherein the wick is expandable and retractable therein and for claims 13 and 14, Webster defines a "swab" as a yarn mop; a wad of absorbent material usually wound around one end of a small stick and used for applying medication or for removing material from an area or a sponge or cloth patch attached to a long handle and used to clean the bore of a firearm for which the references as applied meets the limitations.

It is noted in response to arguments regarding motivation, that the tool of Leatherman is not for a specific function only, contrary to Applicant's statement, a "multiple" tool by definition is designed for various functions, and depending on the intended use and suggestions by the teaching references one of ordinary skill in the art is capable of modifying the tool for various utilities.

The Declaration under 37 CFR 1.132 filed 06/06/03 is insufficient to overcome the rejection of claims 1-7, 10, 15-17 and 20 since an Affidavit/Declaration submitted under 37 CFR



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1.132 for the purpose of traversing grounds of rejection does not apply to rejections under 35USC102(b), anticipation, as is the case here, over US Patent No. 4,238,862, however, in view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.


10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Hadi Shakeri at (703) 308-6279, FAX (703) 746-3279 for unofficial documents. The examiner can normally be reached on Monday-Thursday, 7:30 AM to 6:00 PM. Official documents may be faxed to (703) 872-9302, after final to (703) 872-9303.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist at (703) 308-1148.



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HS



July 15, 2003